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AFTD

Docket No.: 6001.1040  
Date: November 26, 2007

In re application of: Michael Lee HEARN  
Serial No.: 09/533,685  
Filed: March 23, 2000  
For: DOUBLE-CUT FOLDER WITH COMBINATION CUT AND NIP CYLINDER

Sir:

Transmitted herewith is a **REPLY BRIEF UNDER 37 C.F.R. §41.41** (4 pages) in the above-identified application.

- ☒ Also transmitted herewith are:
- ☐ Petition for extension under 37 C.F.R. 1.136
  - ☒ Return Receipt Postcard
  - ☐ Other:
- ☐ Check(s) in the amount of \$ is/are attached to cover:
- ☐ Filing fee for additional claims under 37 C.F.R. 1.16
  - ☐ Petition fee for extension under 37 C.F.R. 1.136
  - ☐ Other:
  - ☐ Other:
- ☒ The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552.
- ☒ Any filing fee under 37 C.F.R. 1.16 for the presentation of additional claims which are not paid by check submitted herewith.
  - ☒ Any patent application processing fees under 37 C.F.R. 1.17.
  - ☒ Any petition fees for extension under 37 C.F.R. 1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time under 37 CFR 1.136.

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I hereby certify that the documents referred to as attached therein and/or fee are being deposited with the United States Postal Service as "first class mail" with sufficient postage in an envelope addressed to "Mail Stop: APPEAL BRIEF- PATENTS Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on November 26, 2007.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY:   
Jan M. Decker



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Re: Application of: Michael Lee HEARN  
Application No.: 09/533,685  
Filed: 03/23/2000  
Art Unit: 3724  
Examiner: Kenneth E. Peterson  
Attorney Docket No.: 6001.1040  
Title: **DOUBLE-CUT FOLDER WITH COMBINATION  
CUT AND NIP CYLINDER**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

November 26, 2007

**APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. §41.41**

Sir:

Appellants submit this Reply Brief for consideration of the Board of Patent Appeals and Interferences (the "Board") in response to the Examiner's Answer dated September 27, 2007 and in support of their appeal of the Final Rejection dated October 25, 2006. Appellants respectfully reassert each of the arguments asserted in Appellants' Brief dated March 29, 2007, and provide herein only a rebuttal of several of the arguments raised in the Examiner's Answer.

No fee is believed required. If any fee is required at this time, the Assistant Commissioner is authorized to charge payment of the same to Deposit Account No. 50-0552.

## **ARGUMENTS**

The following additional remarks are submitted for consideration by the Board under 37 CFR §41.41.

### **Rejections under 35 U.S.C. §102(e)**

#### **Bussey, III et al.**

Claims 22, 26 and 33 were rejected under 35 U.S.C. §102(e) as being anticipated by Bussey, III et al. (U.S. 6,418,827).

With further respect to the Examiner's new arguments, brush roller 45 in Bussey is not a cylinder, nor has the Examiner even asserted that the brush roller is a cylinder (which it is not).

Withdrawal of the rejection to claims 22, 26 and 33 is respectfully requested.

### **Rejections under 35 U.S.C. §102(b)**

#### **Wolfberg et al.**

Claims 22, 26, 28, 30, 33 and 36 were rejected under 35 U.S.C. 102(b) as being anticipated by Wolfberg et al. (U.S. 3,866,497).

Claims 22 and 33 have every limitation that was before the Board and were allowed over Wolfberg et al. Claims 22 and 33 were fully argued and everyone up to this stage, including the Board, the Applicant and the previous Examiner have agreed on the definition of nip. (See prior Office Action of May 15, 2006, paragraph 1). To require new claim language after having given a final rejection is unfair and prejudicial. Moreover, claims 22 and 33 are patentable over Wolfberg et al. as per the previous board decision dated January 18, 2006, and the Patent Office is estopped from giving new arguments at this stage. See MPEP 1214.04. The exact same arguments in the previous appeal are presented again by the Patent Office.

In the Examiner's Answer of September 27, 2007, it is asserted that the Patent Office is not estopped from revisiting the 102(b) rejection under Wolfberg et al. because "the situation is somewhat different from last time". The MPEP in 1214.04 clearly provides a different approach to the Examiner: "*The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references*". Here the Examiner's Answer does not even provide any new or better references for the rejection under 102(b). The Examiner uses the same Wolfberg et al. reference again for the same rejection even after this rejection had been fully argued and the rejection had been reversed by the Board decision of January 18, 2006. There is no known basis to justify ignoring the Board's reversal on a rejection and certainly it does not justify this by merely asserting that the "situation is somewhat different". In addition to the substantive arguments, the Board's decision on reversal of the 102(b) rejections under Wolfberg et al. should stand in accordance with 1214.04 and not be argued again. To do otherwise would permit the Patent Office to reargue references ad infinitum merely by asserting that the arguments are new.

Withdrawal of the rejection to claims 22, 26, 28, 30, 33 and 36 is respectfully requested.

#### **Rejections under 35 U.S.C. §103(a)**

##### **Brown, Jespersen**

Claims 22, 26, 28 and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. 2,951,410) in view of Jespersen (U.S. 4,142,431).

The Examiner's argument on page 14 with respect to Brown is that the "web can hang there until the user is ready to use it. From this we can see that Brown would benefit from perforating instead of cutting all the way thru, so that the product web can hang there in an easy-to-grab position, until the user is ready for it." It is respectfully submitted that one of skill in the art would never let the chaff tape hang in an easy-to-grab position, or even that it is possible for chaff tape to be so provided. Jespersen is not for chaff tape but for paper towels.


Withdrawal of the rejection to claims 22, 26, 28 and 33 is respectfully requested.

**CONCLUSION**

It is respectfully submitted that the application is in condition for allowance. Favorable consideration of this Reply Brief is respectfully requested.

Respectfully submitted,

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